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EXAMINER

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3621

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/681,017
Filing Date: November 22, 2000
Appellant(s): DURBIN ET AL.

Timothy J. Ziolkowski, Reg. No. 38,368
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 15 September 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because Appellant argues separately claims 1, 8, 9, 10, 11, 18 and 23.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,272,636	NEVILLE et al.	8-2001
6,360,254	LINDEN et al.	3-2002

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5,737,424	ELTETO et al.	4-1998
6,115,471	OKI et al.	9-2000

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

Claims 18-26 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 18 is non-statutory as it recites non-functional data. Specifically, the claim is non-statutory because it is directed to a computer program not stored on a computer readable medium. Similarly, claim 23 is non-statutory because a carrier wave is not a computer readable medium as it is not persistent storage.

Claims 19-22 and 24-26 are also rejected as they depend from claims 18 and 23 respectively.

Claim Rejections - 35 USC § 112

Claims 11-14 and 16-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites conditional language without sufficiently providing one of ordinary skill instructions for proceeding in the event at least one of the

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conditions fails (see claim 18 and its use of "otherwise"). Therefore, claims 11-14, 16 and 17, have been examined as if the user ID has not been validated, hence claims 12-14, 16 and 17 do not occur.

Claims 12-14, 16 and 17 are also rejected as they depend from claim 11.

Claim Rejections - 35 USC § 102

Claims 1-3, 6, 7, 23, 24 and 26 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Neville et al., U.S. Patent No. 6,272,636.

As per claims 1-3, 23, and 24, Neville et al. teach a system for remotely enabling software comprising: receiving a user ID at a centralized facility from a user, an option-enabling request from the user specifying an option requested to be enabled in equipment at a subscriber station, electronically sending an enabling feature (e.g. electronic confirmation) from the centralized facility to the equipment in the subscribing station and activating the option in the equipment (column/line 13/13-14/15). Neville et al. also teach a software key to enable software previously installed equipment (column/line 13/13-14/15). The step of confirming that an option has not already been enabled is inherent in the teachings of Neville et al. because by contacting the server/clearinghouse, the user is informing the server/clearinghouse that the feature has not been enabled.

As per claims 6, 7 and 26, Neville et al. teach authenticating a user ID and downloading the enabling feature automatically and without further user input (column/line 13/13-14/15).

Claim Rejections - 35 USC § 103

Claims 4, 5, 15, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neville et al., U.S. Patent No. 6,272,636.

As per claims 4, 5, 15, and 25, Neville et al. generally teach a system for executing software on a remote processor (abstract; column/line 10/62-11/5; column 12, lines 48-52). Neville doesn't explicitly recite a client system as a medical imaging scanner. However, an "end-user computer" (column 10, lines 62-67) is elastic enough to encompass any device that "accepts structured input, processes it according to prescribed rules, and produces the results as output." Regarding claims 5 and 25, Neville et al. specifically recite "try before you buy", and "crippled" software distribution models (column 2, lines 11-47), therefore, it would have been obvious to one of ordinary skill to use the secure product execution method of Neville et al. to activate trial options or features (column/line 13/13-14/15).

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neville et al., U.S. Patent No. 6,272,636 in view of Linden et al., U.S. Patent No. 6,360,254.

As per claims 8 and 9, Neville et al. teach a system for enabling software options in a computer (abstract). However, Neville et al. do not specifically recite sending enabling features by e-mail and electronic confirmation of the option enablement. Linden et al. teach a secure method for enabling a remote computer to access a resource comprising sending an enabling feature by e-mail and sending a verification e-mail to the user confirming option enablement (column 11, lines 28-39). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Neville et al. and Linden et al. as Neville et al. generally recite a server computer enabling a software feature running on a remote client system via telecommunication means and services ('636, column 10, lines 62-65). Hence as electronic mail is such a means and service it would have been obvious to use the e-mail teaching of Linden et al. ('254, column 11, lines 28-39).

Claims 10-14 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neville et al., U.S. Patent No. 6,272,636 in view of Elteto et al., U.S. Patent No. 5,737,424.

As per claims 10-14, 16-18, Neville et al. teach validating an options request, creating an option key in response thereto, a communications network for relaying data, and transmitting the option key through an external communications network (figures 8 and 9; column 10, lines 62-65; column/line 13/13-14/15). Neville et al. generally teach a system for executing software on a remote processor (abstract; column/line 10/62-11/5; column 12, lines 48-52). Neville doesn't explicitly recite a client system as a medical imaging scanner. However, an "end-user computer" (column 10, lines 62-67) is elastic enough to encompass any device that "accepts structured input, processes it according to prescribed rules, and produces the results as output." Neville et al. also teach receiving and validating a user ID/system ID, receiving an option request from a user and invalidating a user ID/system ID (column 13, lines 20-35), comparing the request against other requests (column 13, lines 20-25 and 60-67) and "try before you buy" and "crippled" software distribution models (column 2, lines 11-47). Regarding "trial software", Neville et al. recite evaluation periods based on a number of executions or time periods (column 13, lines 60-67) and tracking the number of user requests for a digital product (column 13, lines 20-25). However, Neville et al. do not specifically recite generating an option key in response to a user request. Elteto et al. teach a method and system for securely distributing software comprising the generation of an option key in response to a user request (column 1, lines 48-60). Therefore, it would have been obvious to one of

ordinary skill to combine the teachings of Neville et al. and Elteto et al. in order to prevent the uncontrolled distribution of software.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neville et al., U.S. Patent No. 6,272,636 and Oki et al., U.S. Patent No. 6,115,471 as applied to claim 18 and in further view of Ernest, U.S. Patent No. 4,888,798.

As per claim 19, Neville et al. teach a client transmitting to a server (that is connected to a plurality of clients) a user ID/system ID for authentication with an option enabling request, comparing the request against other requests and the server distributing software keys over a communications network to the client for enabling software options in response to the client's transmission (abstract; column/line 13/13-14/15). Neville et al. also disclose "try before you buy" and "crippled" software distribution models (column 2, lines 11-47). Elteto et al. teach generating keys after receiving a user request (column 1, lines 49-61). However, neither Neville et al. nor Elteto et al. specifically recite a software key with a disablement feature. Earnest teaches a system for securing distributed software using software keys, with a predetermined time based disablement option, to unlock specific features (column/line 14/66-15/30). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Neville et al., Elteto et al., and Ernest in order more securely control trial period software.

Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neville et al., U.S. Patent No. 6,272,636 and Elteto et al., U.S. Patent No. 5,737,424 as applied to claim 18 above, and in further view of Oki et al., U.S. Patent No. 6,115,471.

As per claims 20-22, Neville et al. teach a client transmitting to a server (that is connected to a plurality of clients) a user ID/system ID for authentication with an option enabling request, comparing the request against other requests and the server distributing software keys over a communications network to the client for enabling software options in response to the client's transmission (abstract; column/line 13/13-14/15). Elteto et al. teach generating keys after receiving a user request (column 1, lines 49-61). However, neither Neville et al. nor Elteto et al. specifically recite authenticating a user ID prior to receiving a request and system ID. Oki et al. teach a software distribution system comprising authenticating a user ID, prior to receiving an option enabling request and receiving then authenticating a system ID (column/line 7/55-8/11). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Neville et al., Elteto et al., and Oki et al. in order to prevent illegal copying of software ('471, column 8, lines 1-5).

(11) Response to Argument

The Examiner withdraws the Objection to claims 18 and 22, and the 112 First Paragraph Rejection to claims 7, 12-14, 16, 17 and 26.

101 Rejection

Regarding non-statutory subject matter the MPEP (2106, Section IV, B) is clear,

Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material.

Hence, as claim 18 is dedicated to a computer program without computer readable medium, claim 18 is non-statutory.

112 Second Paragraph

An essential purpose of patent examination is to fashion claims that are **precise, clear, correct, and unambiguous**. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process (MPEP 2106-07, In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322) (Fed. Cir. 1989) (Emphasis added)

The MPEP (2106-07) also states, "Office personnel must always remember to use the perspective of one of ordinary skill in the art." Therefore, one of ordinary skill is not provided with sufficient data to make and/or use the invention as

Appellant's claims and Specification lack guidance regarding how the system is to perform if for example, the User ID is not validated.

102(e) Rejection

Claims 1 and 23

Neville et al. teach a sending a request/user ID to a server/clearinghouse (i.e. facility) ('636, column 13, lines 17-20) ("receiving a user ID at a facility from a user"). The request/user ID acts as a request, from a client to the server/clearinghouse, for a key to unlock locked software ('636, column 13, lines 25-27) ("receiving an option-enabling request from the user specifying an option to be enabled in equipment at a subscribing station"). Neville et al. also teach "at a centralized facility, confirming that the option has not already been enabled" because the server/clearinghouse determines whether or not the user is eligible to receive the unlock key ('636, column 13, lines 30-35). And if, the user is eligible to receive the unlock key, the user receives the key from the user and unlocks the software (i.e. option).

The Appellant is of the opinion that the Neville et al. system is insufficient prior art, because, the actions of Neville et al. are performed by a "client computer". However, this is in line with Applicant's teachings as the user, in the Appellant's system, sends a user ID over a computer network (Specification, paragraph [0023]). Regarding, an option-enabling request, the option to be enabled, in the Neville et al. teaching, is the software. Recall, a user is allowed access to software for a fixed time period, after which

the software is disabled ('636, column 13, lines 35-43; column/line 13/64-14/3). Hence, in order to "re-enable" the software, a request is made by a user for an unlock key to unlock locked software. Regarding Appellant's "confirming" step, the server/clearinghouse initially receives a request from a user ('636, column 13, lines 57-59). This is the first indication that the user is not using the software, otherwise, the user would not have a reason, in light of the teachings of Neville et al., to request an unlock key. The "confirmation" comes from the server/clearinghouse checking a use history database to confirm whether this is so ('636, column 13, lines 30-35; column/line 13/60-14/3).

103 Rejection

Claims 8 and 9

The Appellant is of the opinion that the prior art of Neville et al. and Linden et al. cannot be combined and are unrelated. To make their point, Appellant resorts to attacks on the Examiner. Specifically, the Appellant openly questions the Examiner's ability to identify and correctly analyze prior art ("the result of a key-word search"). The Examiner respectfully disagrees with the Appellant's assertion. Specifically, the common denominator with regard to the teachings of Neville et al. and Linden et al. is access. That is to say, both Neville et al. and Linden et al. teach providing a user with access to an "option" by transmitting an enabling code (e.g. key, webpage). Neville et al. also teach "verifying the option activation" as the user uses the unlock key to unlock

the software (i.e. option). Neville et al. however, do not limit the means and method for transmitting said enabling code, only that it is performed over a telecommunications network ('636, column 13, lines 13-20). Hence, it would have been obvious to one of ordinary skill to use a network such as the internet, such as e-mail ('254, column 11, lines 28-39), to distribute the unlock key. Note the e-mail is a "verification e-mail" as it provides evidence ("confirms") that the unlock key ("option enablement") and was sent.

Claim 10

The Appellant is of the opinion that Elteto et al. cannot be combined with Neville et al. because Neville et al. stores the key. The MPEP guides the Examiner to ***always*** use the perspective of one of ordinary skill in the art (MPEP 2106-7, "Review the Claims"). Initially, in order to implement a cryptographic system a cryptographic key must be created. To one of ordinary skill of computer security, storing a secret (e.g. encryption key) on a computer for any length of time, or reusing the same secret (e.g. encryption key) over and over again, increases the likelihood that the secret can be compromised. However, this threat can be significantly decreased by generating a key "on the fly", using "one-time pads", or "randomizing" the key by adding random bits (A reference is to be considered not for what it expressly states, but for what it would reasonably have suggested to one of ordinary skill of the art (*In re Delisle*, 160USPQ 806 (CCPA 1969))). Therefore, it would have been obvious to one of ordinary skill to combine the systems of Elteto et al. and Neville et al. in order make the system more

secure by generating the unlock, or option key in response to a user request (i.e. "on the fly") ('424, column 1, lines 48-60).

Claim 11

During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (Emphasis added)

Unlike in claim 18, the Appellant has neglected to include how the system is to perform if certain conditions do not hold. Hence, giving the claims their broadest reasonable interpretation it would have been obvious to one of ordinary skill not perform any other validation if the user ID is not validated (i.e. the user is not entitled to access the unlock key) ('636, column 13, lines 17-28).

Claim 13

It is an undisputable fact that the Appellant's "medical equipment" is a computer (Specification, paragraph 0018) if for no other reason that it runs software (Microsoft Press Computer Dictionary Third Edition defines "software" as a "computer program"). Hence, as the Neville et al. system is directed to computers ('636, figure 6) it would have been obvious for a software developer to use digital production execution control in order to ensure that the developer is compensated for the use of their digital product ('636, abstract; figure 1).

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Note, the term “medical equipment” is broad enough to read on a computer in medical facility or a computer that process medical data.

Claim 18

The Appellant is of the opinion that the prior art does not teach a comparison of “the option-enabling request with any other option requests for that system ID”. The Examiner respectfully disagrees. Initially, the Examiner would like to point out that the claim 18 uses the term “**any**”. Hence, it reads on a system **without** other option requests. Therefore, to one of ordinary skill the claim language suggests in this instance the generating and forwarding of the option key to the user (‘636, column 13, lines 15-37). Nonetheless, Neville et al. also teach receiving and validating a user ID/system ID (a user ID is also a system ID), receiving an option request from a user and invalidating a user ID/system ID (column 13, lines 20-35) and comparing the request against other requests (column 13, lines 20-25 and 60-67). By tracking requests Neville et al. are able to determine whether the user has exceeded a trial period or a prescribed number of executions (‘636, column/line 13/64-14/3) and reject a user’s request (e.g. 11th request) if it equals, or matches, the number, or amount that triggers the “end of evaluation” message (‘636, column 13, lines 33-35).

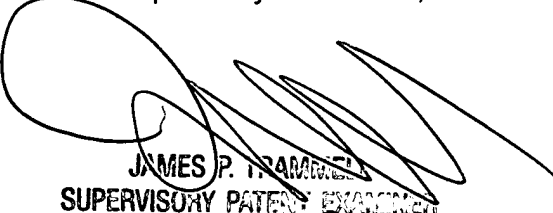
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Conclusion

Appellant's arguments are not persuasive in that they intentionally misconstrue the clear teachings of the prior art and do not give fair credit to the level and knowledge of those of ordinary skill in the computer and computer security art.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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Calvin Loyd Hewitt II
November 9, 2004

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